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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 272

RIPPLE SOLE CORPORATION,
Plaintiff-Petitioner,
vs.
AMERICAN BILTRITE-RUBBER CO., INC.,
Defendant-Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT and APPENDIX

EDWIN J. BALLUFF,
CHARLES R. McKINLEY,
3153 Penobscot Building,
Detroit 26, Michigan;
WARREN C. HORTON,
208 South LaSalle Street,
Chicago 4, Illinois,
Attorneys for Plaintiff-Petitioner.

Of Counsel:
IRVING U. TOWNSEND, JR.,
79 Milk Street,
Boston 9, Massachusetts.

Interstate Brief & Record Co., 356 Congress St. E., Detroit 26, Michigan

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Defendant-Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner, Ripple Sole Corporation, plaintiff-appellant below, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, dated April 16, 1963, peremptorily affirming the decision of the United States District Court for the District of Massachusetts denying petitioner's Motion under Rule 60(b) F.R.C.P. for relief from the original judgment of the District Court entered April 4, 1961, holding invalid Hack patent No. 2,710,461, for "Resilient Shoe Soles." The judgment sought to be reviewed here was peremptorily entered by the Court of Appeals upon its granting of defendant's Motion to Affirm the Appeal under C.A. 1 Rule 25(3).

OPINIONS BELOW

The opinion of the United States Court of Appeals for the First Circuit is reported at 316 F. 2d 54, and is printed in the appendix hereto. The unreported opinion of the United States District Court for the District of Massachusetts dated February 12, 1963, is also printed in the appendix.

The opinion of the District Court holding the Hack patent 2,710,461, invalid is reported at 192 F. Supp. 551. The opinion of the Court of Appeals for the First Circuit affirming such District Court judgment is reported at 302 F. 2d 2, and was entered on May 3, 1962. Rehearing was denied without opinion. Cert. den. 371 U.S. 876.

JURISDICTION

The judgment of the Court of Appeals sought to be reviewed was entered on April 16, 1963.

This court has jurisdiction under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Was the Court of Appeals for the First Circuit under the summary motion procedure provided by C. A. 1 Rule 25(3) warranted in peremptorily ruling on an appeal from a final judgment of the District Court where the Court of Appeals did not justify such disposition on either of the grounds sanctioned by such rule, but rather affirmed the decision below, purportedly on the merits, without affording appellant an opportunity to be heard on the merits of the

questions involved in the appeal and without determining the basic issue involved in the appeal?

2. Where defendant's deliberate change in conduct subsequent to an appeal repudiated the basis of its successful challenge of the validity of the patent it was charged to infringe, does such repudiation manifestly constitute a circumstance warranting the granting of a motion under Rule 60(b) F.R.C.P. for relief from the judgment grounded thereon?

COURT RULE INVOLVED

The pertinent portion of the First Circuit Rule 25(3) under which plaintiff's appeal from the decision denying its Motion under Rule 60(b) was docketed and the decision below affirmed without a hearing on motion of defendant is as follows: Rule 25—Motions

> "(3) To Affirm or Dismiss. The court will entertain a motion to affirm on the ground that it is manifest that the appeal was taken for delay only, or that the questions on which decision of the cause depends are so unsubstantial as not to need further argument. The motion to affirm may be united in the alternative with a motion to dismiss. Although the court upon consideration of a motion to dismiss or a motion to affirm may refuse to grant the motion, it may, if it concludes that the case is of such character as not to justify extended arguments, order the cause set down for immediate hearing."

STATEMENT OF THE CASE

This suit for infringement of the Hack patent 2,710,461 arose out of defendant's manufacture and sale of shoe soles marketed as "Tru-Glide" soles. The defendant's "Tru-Glide" sole with which the original trial was concerned included a number of colorable changes of the patented sole by which defendant sought to avoid infringement while appropriating the Hack invention.

The principal advantage of the patented shoe sole and the new function or result achieved by it are that as a shoe with the patented sole is rolled down in a normal walking stride, the rearwardly inclined resilient ribs move the shoe forwardly a slight distance to obtain what is referred to as "forward propulsion". The novel rib construction of the patented sole and the forward propulsion that it provides also produce the additional advantages of increased resiliency and comfort.

At the trial the defense of invalidity was premised essentially upon the arguments and contentions advanced by defendant's witnesses and counsel that the advantages claimed for the patented sole were trivial and insignificant, if not actually nonexistent, that the patented sole was without merit, and that such commercial success as the patented sole had enjoyed was due to a temporary style trend or fad rather than to the ability of the patented sole to perform its new function of forward propulsion.

The District Court found the Hack patent invalid for lack of invention because it did not produce any of the advantages claimed for it and because it was unpatentable over Lacoste French patent No. 902,385. The District Court's finding of invalidity was based upon its conclusion

that, as asserted by defendant's witnesses and counsel at the trial, the Hack patent did not produce any of the advantages claimed for it. After adopting defendant's contentions that the patented sole did not produce its claimed advantages and, thus, did not provide any new function or result, the District Court equated the patented sole with the saw-cut wooden soles of the Lacoste French patent, which likewise was not shown to provide the new function of forward propulsion.

The judgment of invalidity was affirmed by the Court of Appeals, which adopted the District Court's conclusion that it had not been shown that the Hack structure produced any of the advantages claimed for it, and characterized the patented shoe sole as being a trifling device contributing little, if anything, to the real advancement of the art to which it pertains.

Approximately one month after the Court of Appeals' decision of May 3, 1962, affirming invalidity of the patent, the defendant adopted a new sole construction and for the first time placed on the market a sole that it identified as the "Magic Tread" sole which is *identical* to plaintiff's commercial soles and to the soles disclosed and claimed in the Hack patent. Plaintiff promptly filed its Motion under Rule 60(b)*, for relief from the District Court's judgment holding the patent invalid on the ground that the defendant's repudiation of the contentions advanced by it at the trial, as evidenced by its belated manufacture and sale of a sole identical in all respects to the patented sole, constituted proof of the utility and merit of the patented sole and that such utility being conclusively established, the validity of the patent should be re-examined in the light of such fact.

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*Appendix, pp. 21-26.

A hearing was held in the District Court on plaintiff's Motion under Rule 60(b) at which plaintiff introduced evidence concerning defendant's change of position by its adoption of the "Magic Tread" sole and also evidence concerning increased sales of the patented sole subsequent to the District Court's decision holding the patent invalid, to show that the District Court's conclusion that the patented sole merely represented a temporary style trend or fad, as urged by defendant, was clearly erroneous. In its opinion (Appendix pp. 26-28) on plaintiff's motion under Rule 60(b), the District Court held that neither commercial success nor imitation by the defendant is evidence of validity when the patent has been finally held to lack patentable invention.

Plaintiff's notice of appeal to the Court of Appeals from the District Court's decision denying the Motion under Rule 60(b) was filed on March 11, 1962. Prior to the filing of the record on appeal and prior to plaintiff's submission of its brief on appeal, defendant filed its Motion under Rule 25(3) of the Rules of the Court of Appeals for the First Circuit, asking the Court to docket and affirm or dismiss the appeal under C.A. 1 Rule 25(3) on two grounds, only one of which is relevant here, namely that the questions on which decision of the cause depends are manifestly so unsubstantial as not to need further argument.

The Court of Appeals thereupon rendered its opinion affirming denial of plaintiff's Motion to Reopen under Rule 60(b) without a hearing and without according plaintiff an opportunity to argue the merits of such Motion.

ARGUMENT

The Court of Appeals Was Not Warranted under the Summary Motion Procedure Provided by C. A. 1 Rule 25(3) in Peremptorily Affirming an Appeal from a Final Judgment of the District Court Where the Court of Appeals Did Not Justify Such Disposition on Either of the Grounds Sanctioned by such Rule, or Consider the Basic Issue Involved in the Appeal.

C. A. 1 Rule 25(3) permits the Court of Appeals to entertain a motion to affirm an appeal on the ground that it is *manifest* that the appeal was taken for delay only, or that the questions on which decision of the cause depends are so unsubstantial as not to need further argument.

Defendant-Appellee moved to affirm or dismiss the appeal on two grounds—only one of which is relevant here, namely that the questions on which the decision of the cause depends are manifestly so unsubstantial as not to need further argument.

In its brief in opposition to such motion, Appellant showed, *inter alia:*

1. The issues on appeal are substantial and vital to a proper determination of the validity of the patent involved and should be determined by the Court of Appeals inasmuch as there had been no determination of such issues by the District Court in denying appellant's motion to reopen under Rule 60(b) F.R.C.P.

2. The post-appeal change in conduct of defendant in repudiating the basis of its successful challenge of the validity of the patent it was charged to infringe, is crucial evidence which logically leads to a reversal of the original decision of invalidity since such evidence destroys the basis for such decision, and such decision does not truly reflect the merits of the case.

In granting the motion to affirm without a hearing, the Court of Appeals did not hold that appellant's questions are *manifestly* so unsubstantial as not to need further argument, but rather after casting aside the proffered evidence as relevant, but not of primiary importance, went on to hold that since its earlier decision of May 3, 1962 had held the patent to be invalid (without any doubt), the proffered evidence was quite insufficient to support a different conclusion.

The Court of Appeals thus peremptorily affirmed the appeal on the "merits" by finding the proffered evidence inadequate to counterbalance the prior decision, instead of passing on the defendant's motion on the ground asserted—namely, that the questions presented on appeal are *manifestly* so unsubstantial as not to need further argument. It is clear from the Court of Appeals' decision of April 16, 1963, that it affirmed the District Court because it perfunctorily treated the proffered evidence as evidence of commercial success rather than as a repudiation of the basis on which the holding of invalidity in this case was bottomed. The District Court treated the proffered evidence in the same erroneous fashion. However, the issue is not one of merely weighing evidence of commercial success in the balance against invalidity, but rather one requiring re-examination of the correctness of the holding of invalidity in view of the fact that the keystone for such holding—lack of utility and lack of a new result or function—has been repudiated by the post-appeal conduct of the defendant.

It is apparent from the decision of February 12, 1963, that the District Court rejected the new evidence essentially because of its evident concern with adherence to its prior

decision "which the Court of Appeals has held was 'clearly correct'", rather than with whether such decision in view of the new evidence truly reflects the merits of the case, the basic issue raised by petitioner's Motion to Reopen under Rule 60(b). The Court of Appeals in granting defendant's motion to affirm similarly dismissed the new evidence as not of primary importance because of its unduly high regard for its previous affirmance of the "clearly correct" holding of invalidity by the District Court. Thus the District Court denied the Motion to Reopen because the Court of Appeals had said that its original decision was "clearly correct", and the Court of Appeals peremptorily disposed of the appeal because it had previously held the District Court's decision to be "clearly correct". It cannot be denied that the new evidence is of primary significance on the issue of repudiation of the basis of the District Court's decision of invalidity. Neither Court faced the issue raised by Plaintiff's Motion to Reopen under Rule 60(b) that since the post-appeal conduct of the defendant had destroyed the keystone of the original finding of invalidity, a re-examination of such finding in the light of the new evidence was required in order that the judgment accurately reflect the merits of the case. The new evidence demonstrates that the finding of lack of utility and lack of any new result—the premise of the decision on invalidity—cannot stand, and therefore the decision predicated on such false premise logically cannot stand and legally should not be permitted to stand.

To warrant the summary affirmance under C. A. 1 Rule 25(3) of the appeal taken by petitioner here, the Court of Appeals under the test of *Hamilton v. Regents* (1934) 293 U.S. 245, 258, would have to determine that

> "* * * every question that appellants have brought here for decision is so clearly not debatable and utterly lacking in merit as to require dismissal for want of substance."

However, rather than making any such determination, the Court of Appeals while recognizing the evidence as relevant, purported to determine the appeal on its "merits" but without considering whether the new evidence destroyed the premise of the original decision, as petitioner asserts, and, if so, whether there was any true merit to petitioner's contention that without such premise the decision logically could not stand. It was illogical and erroneous for the courts below to have let the prior decision of invalidity preclude their consideration of proof that such decision was founded upon an erroneous finding as to the utility and advantages of the patented sole.

Plaintiff's Motion to Reopen under Rule 60(b) would be a futile gesture indeed if it could be legally cast aside with the perfunctory answer given by the courts below to the effect that the prior decision will not be re-examined because the Court of Appeals held that it was clearly correct. A Motion to Reopen under Rule 60(b) on the ground that the post-appeal conduct of the prevailing party demonstrates that the premise of the decision is erroneous cannot legally be said to be of no substance. It is an exceptional circumstance tantamount to the repudiation of crucial testimony by a material witness. And an appeal from a decision denying such motion where the Court's opinion does not even discuss such a basic issue cannot legally or rationally be dismissed as of no substance. If the decision of invalidity was procured by what now clearly appears as spurious contentions, the conscience of the Court of Appeals, as well as that of the District Court, as courts

of equity, should be shocked to a point where neither of them should allow such decision to stand. In effect, the defendant put over its contentions contrary to its real evaluation of the invention and then, having secured an adjudication based upon erroneous representations, used the resulting adjudication to justify its slavish appropriation of the patented invention, theretofore characterized by it as merely a fad of no real merit. If plaintiff's contention is correct, the District Court and the Court of Appeals cannot legally dispose of such a serious charge merely by ignoring it. If before the trial the defendant had resorted to such slavish copying of the patented sole as it did after the appeal, it would have been precluded from making the defense which formed the keystone of the Court's finding of invalidity. It is no answer for a court of equity to say now, as did the courts below, that since we have already held the patent invalid we will not re-examine the basis of our decisions or discuss your charges. This kind of reasoning by the Courts below effectively nullifies the provisions of Rule 60(b).

If the patented sole has the utility claimed for it by petitioner and now acknowledged by appellee, the world's largest manufacturer of shoe soling, then the stature of the patent vis-a-vis that of the saw-cut wooden block sole of Lacoste has been significantly increased over that erroneously assumed by the District Court as the basis of its finding of anticipation by Lacoste. In other words, the defendant's conduct demonstrates as a fact that there is much more to the patent than what it originally represented to the Court, and if such is true, as the defendant cannot now deny, then the Court was in error in equating Lacoste with the patent in suit as a basis for the finding of invalidity.

Both courts below held that after the Court of Appeals had held the patent in suit invalid, its structure could be copied with impunity by defendant. This not only begs the question but also reflects the sacrosanct regard of both courts for their prior decisions and supports petitioner's contention here that neither court below considered whether the prior decision, in view of the new evidence, truly reflects the merits of the case.

As the Court of Appeals has not held and could not properly hold that manifestly there is no substance to the appeal, and as its summary opinion of April 16, 1963, affirming the appeal cites no reason for not considering the basic issue of the appeal, it was not warranted in affirming the appeal under C. A. Rule 25(3).

In *Foman v. Davis* (Dec. 1962), 83 S. Ct. 227, in reversing the C. A. 1 for disposing of an appeal on technicalities, Justice Goldberg in speaking for the Court stated:

> "It is too late in the day and entirely contrary to the spirit of the Federal Rules of Civil Procedure for decisions on the merits to be avoided on the basis of * * * mere technicalities."

While the facts of *Foman v. Davis* are somewhat different, the case does involve the refusal of the courts below to hear and decide a matter on its merits. The principle and the spirit of *Foman v. Davis* are directly applicable here in view of the failure of the courts below to consider the basic issue of the appeal.

The Defendant's Change in Conduct Subsequent to the Original Appeal Decision of May 3, 1962, Is an Admission That the Contentions Advanced by It at the Trial in Derogation of the Patented Sole Were Erroneous, and Where Such Contentions Form the Keystone of the Court's Decision of Invalidity, the Repudiation of Such Contentions Manifestly Forms a Basis for Reopening under Rule 60(b).

Obviously the courts should not permit a prevailing party to profit by its misrepresentations of material facts even if at the time they were made it mistakenly believed them to be so. Rule 60 empowers courts to set aside judgments under circumstances in which it would be inequitable to permit a judgment to stand. It has been held that the rule should be liberally construed in order that the judgment will truly reflect the merits of the case. *Padgett v. United States*, 272 F. 2d 774, and *Serio v. Badger*, 266 F. 2d 418. As stated by Mr. Justice Black in *Klapprott v. United States*, 335 U.S. 601, 615, subdivision 6 of Rule 60(b) (upon which petitioner here relied):

> "* * * vests power in courts adequate to enable them to vacate judgments whenever such action is appropriate to accomplish justice."

In the present case the new evidence pertaining to defendant's new "Magic Tread" sole came into existence during the first part of June 1962, shortly after the Court of Appeals' decision of May 3, 1962, affirming the District Court's holding of invalidity, and hence such evidence did not exist at the time of the trial and no question of lack of diligence in discovering or producing such evidence has been raised. Petitioner's Motion to Reopen under Rule 60(b) was filed in the District Court on July 17, 1962.

The new and significant evidence relied upon by petitioner in support of its Motion to Reopen comprises:

1. The post-appeal action of American Biltrite Rubber Co., Inc., the defendant, in manufacturing and selling a "Chinese copy" of the patented sole after basing its successful defense of invalidity on the premise that the patented sole was without merit and so persuading the District Court and the Court of Appeals who used such premise as the keystone of their decisions.

2. The continuing significance of the patented sole in the market in the face of infringement by the defendant, the world's largest manufacturer of shoe soling, and the Japanese importations, as set forth in the Affidavit of Morton Hack, and notwithstanding the defendant's contention at the trial that "the ride is over" (original transcript p. 721),

3. The walking demonstration by Alfred E. Wilson in open court and his affidavit showing that the "forward propulsion" action of the patented sole, identical with the defendant's new "Magic Tread" sole, operates in actual walking to increase the length of stride, and the affidavit of Dr. Peter V. Karpovich that such demonstration is a valid demonstration that the patented sole "in actual walking increases the length of stride without the expenditure of additional effort."

In the light of such new and significant evidence, the following material findings of the District Court cannot stand:

> "* * * it cannot be found that the Hack structure produces any of the advantages claimed for it";

> "It appears as the most probable explanation that the sole had a certain novelty which enabled it to catch on as a temporary style trend, but it is not established that it has as yet succeeded in permanently capturing any segment of the sole market."

These findings are the keystone of the District Court's decision.

The defendant's post-appeal conduct in offering its "Magic Tread" sole, a slavish imitation of the patented sole, is a complete reversal of the position which the defendant took at the trial and before the Court of Appeals, and shows conclusively that the arguments and contentions advanced by it before such Courts to discredit the patented sole were erroneous and have misled both Courts into the belief that the patented sole is merely a trifling device and has no real advantage over conventional soles.

The defendant's contention and the Courts' findings based thereon that the patented sole was merely a temporary style trend and that it does not possess the claimed advantages to any appreciable extent cannot stand in view of the defendant's now apparent scheme to capitalize on the patented invention by flooding the market created by the plaintiff with low-priced exact copies of plaintiff's commercial and patented sole.

Thus defendant, not satisfied with making and selling its "Tru-Glide" sole with the chevron design and the sharp edges on the lower ends of the rearwardly inclined ribs (the accused sole before the District Court at the original trial), has now made clear the full extent of its scheme to appropriate and obtain for itself the full advantages of the patented invention by selling exact copies of the patented sole. The defendant has now copied even such details of the patented invention as the rounded ends of the ribs

and the rounded juncture of the ribs with the body of the sole, details which defendant deprecated as minor variations of design. In view of the time required to obtain molds and otherwise tool up for production of its "Magic Tread" soles, defendant at the very time it argued in the Court of Appeals that the patented sole was merely a temporary fad or style trend was preparing for production and marketing of its "Chinese copies."

The defendant's current interest in making a "Chinese copy" of the patented sole is the strongest kind of evidence of the inherent practical merit of the patented sole and demonstrates that the contentions and arguments of the defendant at the trial to disparage the sole were erroneous and misled both of the Courts below. The defendant is one of America's industrial giants, and its decision to make the very substantial investment in molds to now produce the "Magic Tread" sole is belated recognition of the intrinsic merit of the patented sole. Defendant's current plan to capitalize on the patented sole by making a "Chinese copy" of it completely invalidates the premise of its contentions at the trial. If "the ride is over," as defendant's counsel put it to the District Court in January 1961, why is the defendant now spending its money for molds for the "Magic Tread"? Certainly not to buy a ride on a dead horse. The defendant has not denied, indeed it cannot deny, the significance of the new evidence and its primary importance in destroying the basis for the trial court's original decision of invalidity, and in view of such evidence such decision does not truly reflect the merits of the case.

Defendant's post-appeal conduct demonstrates as a fact that there is far more to the patent than what defendant originally represented to the trial court as the basis for securing the decision of invalidity, and if the sole has the

utility claimed it by petitioner, as the defendant cannot now deny, then the trial court was in error in equating Lacoste with the patent in suit as a basis for its finding of invalidity. Otherwise stated, the recognition now accorded the patented sole by the defendant is potent evidence that the alleged similarities of the saw-cut wooden block sole of Lacoste with the patent in suit erroneously assumed by the District Court as the basis of its finding of invalidity over Lacoste, are superficial indeed. Defendant is free to make the saw-cut wooden block sole of Lacoste with impunity, but it knows as a practical matter that Lacoste is worthless and, having served its purpose, can now be relegated to the archives. Whatever the differences are between Lacoste and the patent, and there are many, these differences are significant as evidenced by the defendant's decision to make a "Chinese copy" of the patented sole, rather than of Lacoste.

Defendant's post-appeal adoption of its "Magic Tread" sole is proof enough of the fact that the patented sole has utility not only within the meaning of the patent statutes, but great commercial significance and utility as well, and defendant should be estopped to deny that the patented sole achieves its claimed advantages, as it argued before the Courts below. Here, as in *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U.S. 428, 441, the defendant asserts that the "art was crowded with numerous prototypes and predecessors" which possessed all of the qualities of the patent in suit, thus giving the tribute of its praise to the prior art but giving to the patent in suit the tribute of its imitation. In rejecting a like contention by the infringer in the *Diamond Rubber* case this Court said:

> "That the tire is an invention is fortified by all the presumptions, the presumption of the patent by that arising from the utility of the tire. We have

> said that the utility of a device may be attested by the litigation over it, as litigation 'shows and measures the existence of the public demand for its use.'" (p. 441)

Thus the new evidence is of a character which makes it inequitable to enforce the judgment, and relief is appropriate under Rule 60(b).

It is difficult to imagine a circumstance more appropriate for relief under Rule 60(b) than the complete repudiation by a prevailing party of the position that it took in securing the judgment.

In *L. M. Leathers' Sons v. Goldman* (C.A. 6, 1958), 252 F. 2d 188, the trial court set aside the judgment in a patent case where the prevailing party's conduct *thereafter* was inconsistent with the position taken in securing the judgment. In affirming such action of the trial court, Circuit Judge Miller stated:

> "Rule 60(b)(6) vest power in the court to enable them to vacate judgments whenever such action is appropriate to accomplish justice."

Here, as in the *Leathers* case, the prevailing party's subsequent conduct is inconsistent with the position taken in securing the judgment and manifestly forms a basis for reopening under Rule 60(b).

Wherefore, it is respectfully submitted that the Petition for Writ of Certiorari should be granted to the end that justice may be done in the premises.

Respectfully submitted,

EDWIN J. BALLUFF,
CHARLES R. McKINLEY,
3153 Penobscot Building,
Detroit 26, Michigan. 48226

WARREN C. HORTON,
208 South LaSalle Street,
Chicago 4, Illinois,
Attorneys for Plaintiff-Petitioner.

Of Counsel:

IRVING U. TOWNSEND, JR.,
79 Milk Street,
Boston 9, Massachusetts.

APPENDIX

IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS

Civil Action No. 50-405-F

RIPPLE SOLE CORPORATION,
Appeal No. 5848
Plaintiff,
v.
AMERICAN BILTRITE RUBBER CO., INC.,
Defendant

MOTION BY RIPPLE SOLE CORPORATION, PLAINTIFF, UNDER RULE 60(b), OF THE FEDERAL RULES OF CIVIL PROCEDURE FOR RELIEF FROM THE JUDGMENT ENTERED BY THIS COURT ON APRIL 4, 1961

Now comes Ripple Sole Corporation, plaintiff, and moves this Honorable Court in accordance with the provisions of Rule 60(b) of the Federal Rules of Civil Procedure to relieve plaintiff from the judgment entered by this Court on April 4, 1961, on such terms as are just by reopening the case for the consideration of the new evidence submitted herewith, and to request the Court of Appeals to remand the case to your Honor for such purpose.

The new evidence here relied upon is based upon the fact that the American Biltrite Rubber Company, Inc., defendant-appellee, subsequent to the Court of Appeals' decision of May 3, 1962 (and denial on May 22, 1962, of a

Petition for Rehearing), affirming your Honor's holding that the Hack patent 2,710,461 was invalid, has adopted a new construction for its soles and is now making and selling shoe soles identified as "Magic Tread" soles. These "Magic Tread" soles are identical to plaintiff's commercial soles and to the soles disclosed and claimed in the Hack patent in suit, whereas the defendant's "Tru-Glide" sole originally involved here included a number of colorable changes in a transparent effort to avoid infringement while appropriating the Hack invention. Defendant-appellee's sale of the "Magic Tread" soles was initiated early in June, 1962, about a month after the Court of Appeals' decision. A specimen "Magic Tread" sole of the kind recently adopted by defendant-appellee and a specimen of the plaintiff's patented Ripple sole are filed herewith and a photographic reproduction of the defendant's "Magic Tread" sole is appended hereto.

The decisions of this Court and the Court of Appeals are based on your Honor's finding that it had not been proven that the Hack sole possessed "any of the advantages claimed for it." In adopting such a finding this Court and the Court of Appeals accepted as true certain contentions and representations advanced by the defendant to the effect that the advantages claimed for the patented sole—of forward propulsion, increased resiliency and comfort—were trivial and insignificant, if not actually nonexistent. The defendant's present conduct in this respect is a complete reversal of the position it took at the trial and before the Court of Appeals and shows conclusively that the arguments and contentions advanced by it before your Honor and the Court of Appeals to discredit the patented sole were erroneous and have misled both this Court and the Court of Appeals into the belief that the patented sole is merely a trifling device that has no real advantage over

conventional soles. Defendant's contention and your Honor's finding based thereon that the patented sole was merely a temporary style trend and that it does not possess the claimed advantages to any appreciable extent cannot stand in view of the defendant's now apparent scheme to capitalize on Hack's invention by flooding the market created by plaintiff with low-priced exact copies of plaintiff's commercial and patent sole.

Thus defendant, not satisfied with making and selling the accused "Tru-Glide" sole with the chevron design and the sharp edges on the lower ends of the rearwardly inclined ribs, has now made clear the full extent of its scheme to appropriate and obtain for itself the full advantage of Hack's invention by selling exact copies of Hack's patented sole. Defendant has now even copied such details of Hack's invention as the rounded ends of the ribs and the rounded juncture of the ribs with the body of the sole, details which defendant characterized as but minor variations of design. The very name "Magic Tread" adopted by defendant for its "Chinese copy" of Hack's patented sole recognizes the unique action of the Hack sole.

It is submitted that defendant's current imitation of the Hack sole down to the last detail is indisputable proof of the intrinsic merit of the patented sole and demonstrates that such sole represents far more than a temporary style trend as the defendant represented to this Court.

In addition to the defendant's exact copying of the patented sole and the evidence which was before your Honor at the trial of this case, concerning the sales of Ripple soles* and of the accused "Tru-Glide soles"**, plaintiff is

*Over 9,400,000 pairs up through 1960.

**Over 1,640,000 pairs up through November 1960.

prepared to further show that the sales of Ripple soles by plaintiff's licensee, The Beebe Rubber Company, for 1961, were in excess of 1,750,000 pairs of soles (a 30 per cent increase over 1960); 69,000 pairs of heels and taps; and 47,000 pairs of Stryker Leels (a therapeutic application of the patent in suit in the form of a heel for walking casts); that the sales for the first six months of 1962 were in excess of 900,000 pairs of soles (more than an 18 per cent increase over 1961), 23,000 pairs of heels and taps, and 24,000 pairs of Stryker heels; and that the admitted sales of shoes having soles charged to infringe the Hack patent in suit in the other patent infringement suits referred to in the record are in excess of 1,140,000 pairs. The foregoing evidence of total sales of Ripple soles in excess of 12,000,000 pairs, plus the millions of pairs of infringing imitations, of the patented sole now supplemented by the defendant's identical copying fully merits your Honor's now finding that the commercial success of the Hack sole is impressive.

This motion should be granted and a further hearing had on the issue of the validity of the Hack patent because the defendant's present conduct in producing and selling an *exact imitation* of the patented sole, together with the particulars referring to the extensive sales of the patented sole since this case was tried by your Honor, demonstrates as a fact that the Hack sole does possess the advantages claimed for it and thus has a critical bearing on the issue of validity of the patent.

In view of the fact that your Honor's decision has been affirmed by the Court of Appeals, leave of such Court is required before your Honor may reopen this case for the purpose of considering the new evidence hereinbefore re-

ferred to. Under the practice approved by the Court of Appeals of this Circuit in *United States v. Newberry Manufacturing Company*, 123 F.2d 453, which requires that any request for remand or reopening of a case come from the District Court (rather than from a party), we therefore move this Court to certify to the Court of Appeals how it would rule on this motion and to request the Court of Appeals to remit the case to your Honor for the purpose of hearing and considering this new evidence to the end that Ripple Sole Corporation may be relieved pursuant to the provisions of Rule 60(b) from the decision of this Court on April 4, 1961. Rule 60(b) and particularly subdivision (6), vests power in the trial court for "any other reason justifying relief from the operation of the judgment" whenever such action is appropriate to accomplish justice.

The action of the defendant in now slavishly imitating the patented sole (in view of the colorable changes used in the Tru-Glide sole) is a clear and unequivocal admission or confession that its contentions at the trial that the patented sole lacks merit are not in fact valid. Justice in this case will be accomplished by reopening the case and evaluating the validity of the Hack patent in the light of the defendant's tacit admission that the patented sole does possess real advantages over the prior art, and even over the Tru-Glide sole which defendant originally adopted in its scheme to appropriate Hack's invention with impunity. Indeed, it would be a mockery of justice to permit defendant to misrepresent the real value of the patented sole to this Court and the Court of Appeals as it has done and to capitalize on such misrepresentation as it now plans to do unless restrained by this Court.

A hearing on this motion is respectfully solicited.

This motion is supported by the accompanying memorandum and the affidavit of E. J. Balluff, attorney for Ripple Sole Corporation.

Respectfully,

Balluff and McKinley,
Attorneys for Plaintiff.

OPINION OF JUDGE FORD

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

Civil Action No. 58-405-F

RIPPLE SOLE CORPORATION,
Plaintiff,
v.
AMERICAN BILTRITE RUBBER CO., INC.,
Defendant

OPINION
February 12, 1963

FORD, J.

This is an action for patent infringement in which this court after a full trial entered judgment for defendant, holding the Hack patent No. 2,710,461 invalid for lack of invention and anticipation. *Ripple Sole Corporation v. American Biltrite Rubber Co.*, 192 F. Supp. 551, affirmed, 302 F.2d 2, certiorari denied, 371 U.S. 876. Plaintiff now moves under Rule 60(b) for relief from the judgment of this court and for the reopening of the case for the consideration of new evidence. At the hearing on this motion

plaintiff was allowed to present the testimony and demonstration of an expert witness and to state fully the nature of the additional evidence on which it relies.

This additional evidence falls into two categories. In the first category plaintiff offers to show that since the affirmance of this court's judgment by the Court of Appeals defendant has been marketing soles which are identical with the patented soles. Before this it had marketed the allegedly infringing soles which were generally similar but not exactly identical. Plaintiff also seeks to present further evidence relating to the commercial success of the patented soles and allegedly similar soles.

In the second category dealing with the benefits claimed to have been produced by the patented soles, plaintiff presented a demonstration by witness Wilson intended to show the claimed ability of the patented soles to increase the length of the wearer's stride, and an additional affidavit of another expert, Karpovich, as to his conclusions from witnessing a similar demonstration by Wilson.

There is nothing in all this to indicate to this court that this matter should now be reopened or that its previous decision was erroneous. As both this court and the Court of Appeals have indicated, commercial success is no evidence of validity where it is clear from the other evidence that the patent lacks patentable invention and is anticipated. Hence, additional evidence of commercial success would add nothing. Similarly, imitation by the defendant, while it might in a doubtful case be some indication of the validity of a patent, certainly cannot be so interpreted when the patent has finally been held to lack patentable invention. All this evidence indicates is that the ripple sole construction, while embodying no patentable feature, may nevertheless have some qualities of comfort or appear-

ance which make it commercially successful, and that defendant, having established its legal right to make and sell such soles, now finds it profitable to do so.

The remaining evidence offers nothing really new. The case was tried at length with full opportunity to plaintiff to develop by expert testimony, demonstration and argument its claim to have developed a patentable invention. What it now offers is merely a variation of essentially the same evidence it offered at the previous trial. There would be no end of litigation if after a party has lost its case in the trial court and on appeal, it could have the whole case reopened merely because it believed it could vary its demonstrations to make them more convincing or rephrase its arguments to make them more persuasive.

Moreover, there is nothing in this proffered additional evidence that in any way affects the second ground on which this court relied in finding the Hack patent invalid, i.e., anticipation by the Lacoste French patent. What plaintiff seeks to do on this issue is to attempt by repetition of argument to convince this court that it was wrong in a conclusion reached after full argument and consideration and which the Court of Appeals has held was "clearly correct."

Plaintiff's motion for relief from judgment is denied.

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No.....

RIPPLE SOLE CORPORATION,
Plaintiff, Appellant,
v.
AMERICAN BILTRITE RUBBER CO., INC.,
Defendant, Appellee

APPELLEE'S MOTION TO DOCKET AND TO AFFIRM OR DISMISS UNDER RULE 25(3) OF THIS COURT

Now comes the appellee, American Biltrite Rubber Co., Inc., and represents that appellant, Ripple Sole Corporation, has under date of March 11, 1963, filed in the United States District Court for the District of Massachusetts, its notice of appeal from an order entered in the District Court on February 12, 1963, denying appellant's motion for relief from judgment under Rule 60(b) of the Federal Rules of Civil Procedure.

The appellee moves to affirm or dismiss on the following grounds:

1. The matter has already been presented to and disposed of by this Court, the appellant having filed under date of June 7, 1962, a printed "Petition for Reconsideration of Plaintiff-Appellant's Petition for Rehearing" in Appeal No. 5848, together with a motion for leave to file the same, and the motion for leave to file was denied by order of this Court dated June 28, 1962; and

2. The questions on which decision of the cause depends are so unsubstantial as not to need further argument.

Annexed hereto are the following appendices:

Appendix A. Docket entries July 17, 1962 to date.

Appendix B. Motion by Ripple Sole Corporation, Plaintiff, under Rule 60(b) of the Federal Rules of Civil Procedure for relief from the judgment entered by [the District] Court on April 4, 1961.

Appendix C. Opinion of the District Court February 12, 1963.

Appendix D. Notice of appeal, March 11, 1963.

It is submitted that the appeal should be docketed and dismissed.

Melvin R. Jenney,
Attorney for Defendant-Appellee.

OPINION OF THE COURT OF APPEALS ON MOTION TO DOCKET AND TO AFFIRM OR DISMISS

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6121

RIPPLE SOLE CORPORATION,
Plaintiff, Appellant,
v.
AMERICAN BILTRITE RUBBER CO., INC.,
Defendant, Appellee

Appeal from the United States District Court
for the District of Massachusetts

Before Woodbury, Chief Judge, and Hartigan and Aldrich, Circuit Judges

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Edwin J. Balluff, Charles R. McKinley, Irving U. Townsend, Jr., and Balluff and McKinley for appellant on brief in opposition to motion.

Melvin R. Jenney, Richard R. Hildreth, Clarence S. Lyon, and Kenway, Jenney & Hildreth for appellee on motion and memorandum in support thereof.

OPINON OF THE COURT

ON MOTION TO DOCKET AND TO AFFIRM OR DISMISS

April 16, 1963

WOODBURY, *Chief Judge*. Subsequent to our decision of this case on May 3, 1962, reported 302 F.2d 2, petition for rehearing denied May 22, 1962, motion for leave to file

petition for reconsideration denied June 28, 1962, cert. denied, 371 U.S. 876 (1962), the appellant, Ripple Sole Corp., filed a motion in the court below under Rule 60(b) of the Fed. R. Civ. Proc. for relief from the judgment entered against it by reopening the case, with leave of this court,* for the consideration of new evidence. The new evidence submitted in support of the motion is that after the decision of this court holding the Hack patent invalid, the defendant, American Biltrite Rubber Co., Inc., began to make and market soles in "exact imitation" of the sole disclosed in the patent and that in 1961 the sale of Ripple soles exceeded by over 60% the sale of such soles in 1960. The contention is that such evidence clearly demonstrates as a fact that the Hack sole, contrary to the finding of the court below affirmed by this court, possesses the advantages claimed for it in the patent and thus has a critical bearing on the issue of the patent's validity.

The court below, after hearing, denied the plaintiff-appellant's motion for relief and it promptly on March 11, 1963, filed notice of appeal. The defendant-appellee thereupon moved this court under our Rule 25(3) to docket and to affirm or dismiss that appeal. This is the motion now before us.

The plaintiff-appellant conceded, as it of necessity had to, that the Hack patent acknowledged as old in the art soles designed to give merely springing action. The patentable novelty claimed for the Hack sole was that with each step it gave "forward propulsion" to the foot, thus conserving energy by increasing the length of each stride. The court below after full hearing wrote a carefully prepared opinion wherein it found that the Hack structure

*See *United States v. Newbary Mfg. Co.*, 123 F.2d 453 (C.A. 1, 1941).

did not have the advantage claimed for it, at least to any significant extent. This court after considering the record and arguments held that the conclusion of the court below, instead of being clearly erroneous, was clearly correct, and affirmed.

The evidence now offered to refute that finding falls into two general categories: evidence of "Chinese copying" and evidence of "commercial success." As such the evidence in both categories, although relevant, is not of primary importance on the issue of validity. It is only make-weight evidence to be thrown into the balance when the issue of validity is doubtful. That issue in this case both the court below and this court thought was not doubtful but clear. Wherefore, we think the proffered evidence quite insufficient to support a different conclusion.

Moreover, after this court held the Hack patent invalid, its structure was open to the defendant-appellee to copy if it saw fit. And the commercial success of the structure, for all that appears, could as well be referable to advertising, to continuing fashion, or to the comfort of the sole because of its resilience, as to any possible "forward propulsion" it might afford.

Giving the appellant the benefit of every possible doubt, we see no ground upon which we could say that the court below had abused its discretion in denying the appellant relief under Rule 60(b).

The appellee's motion to docket will be granted, and judgment will be entered affirming the order of the District Court.